



Application Serial No.: 09/750,320
Attorney Docket No.: 042846-0313440

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Andrew ROUSE, *et al.*
SERIAL NUMBER: 09/750,320 EXAMINER: Yuwen Pan
FILING DATE: Dec. 29, 2000 ART UNIT: 2682
FOR: SYSTEM AND METHOD FOR PROVIDING WIRELESS DEVICE ACCESS

Mail Stop Appeal

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

Sir:

In response to the Final Office Action mailed October 19, 2005 (hereinafter "the 10/19/2005 Office Action"), Applicant requests review of the final rejection in the above-identified application. This request is being concurrently filed with a Notice of Appeal. The review is requested for the reasons provided in the **Remarks** beginning on page 2 of this paper. A total of 4 pages are provided.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 033975 (**Ref. No. 042846-0313440**).

Remarks

Claims 21, 22, 24-30, 32-39 and 41-44 are all of the claims pending in this application. No claims are amended, added, or canceled by this paper. In view of the following remarks, reconsideration and allowance of all the claims pending in the application is requested.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 21, 22, 24-30, 32-39, and 41-44 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,701,378 to Gilhuly et al. (hereinafter "Gilhuly") in view of U.S. Patent No. 6,633,759 to Kobayashi (hereinafter "Kobayashi"). Applicants traverse this rejection as being legally improper at least because (1) there is no proper motivation or suggestion to combine Gilhuly and Kobayashi and (2) the cited references do not teach or suggest all of the features of the claimed invention.

1. There is no proper motivation to combine Gilhuly and Kobayashi.

Independent claim 21 recites *inter alia* "executing the at least one selected application action on the at least one server, the application action comprising at least one of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, and searching at least one file within the server." Independent claims 28, 33, and 38 include similar subject matter, among other things. In an exemplary embodiment, the application describes request handlers located on at least one server that may provide the ability for a request from a wireless client device to execute an application action associated with a selected application at a server. See specification at p. 12-13. The requested application action may include opening, closing, editing, saving, deleting, or searching a document, folder, and/or database at the server. *Id.*

The Examiner acknowledges that Gilhuly does not teach or suggest this feature. See 10/19/2005 Office Action at p. 3; and Interview Summary dated July 22, 2005. The Examiner alleges that Kobayashi describes this feature, and proposes that it would

have been obvious to modify Gilhuly according to the teachings of Kobayashi “such that a user would be able to distantly control an application within a remote server without physically being there.” *Id.*

The motivation for combining Gilhuly and Kobayashi provided by the Examiner is improper because it focuses on the effects of the proposed combination. In order to properly combine the cited references the Examiner must instead point to a teaching or suggestion in the prior art of the desirability for combining the references. See *In re Sang-Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed.Cir. 2002) (citation omitted). Since there is no such suggestion in the prior art, the combination of Gilhuly and Kobayashi is improper.

For at least this reason, the rejection of the independent claims 21, 28, 33, and 38 is improper and must be withdrawn. Further, claims 22, 24-27, 29, 30, 32, 34-37, 39, and 41-44 depend from and add features to corresponding ones of the independent claims 21, 28, 33, and 39. Therefore, claims 22, 24-27, 29, 30, 32, 34-37, 39, and 41-44 are allowable based on their dependency, as well as for the features that they add to the independent claims.

2. Gilhuly and Kobayashi do not teach or suggest all of the features of the claimed invention.

Independent claim 21 recites, *inter alia*, “executing a selected application action on at least one server and formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client and a user selection of one or more fields associated with a selected file. Independent claims 28, 33, and 38 include similar subject matter, among other things.

The Examiner maintains that the teaching in Gilhuly of “using a user configuration of the redirector program to push certain user-selected data...to the user’s mobile data communication device device,” and “formatting at least one application action based on a profile of the wireless communication device and user’s selection” correspond to this claim feature. See 10/19/2005 Office Action at page 2. However, since any action taken by the redirector program is automatically executed based on

predetermined triggers, a user is not able to select a particular file, much less a field in the file, prior to the automatic redirection of the file by the redirector program.

Therefore, the application outputs of the redirector program cannot be based on user selections of a particular field in a particular file.


For at least this reason, the rejection of the independent claims 21, 28, 33, and 38 is improper and must be withdrawn. Further, claims 22, 24-27, 29, 30, 32, 34-37, 39, and 41-44 depend from and add features to corresponding ones of the independent claims 21, 28, 33, and 39. Therefore, claims 22, 24-27, 29, 30, 32, 34-37, 39, and 41-44 are allowable based on their dependency, as well as for the features that they add to the independent claims.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: January 19, 2006

Respectfully submitted,

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